

REMARKS

This amendment is submitted in response to the Examiner's Action dated March 16, 2010. Applicants have amended the claims to clarify and/or to more clearly recite the novel features of the invention. No new matter has been added, and the amendments place the claims in better condition for allowance. Applicants respectfully request entry of the amendments to the claims. Where discussion/arguments are presented below to rebut/overcome claim objections and/or rejections, those discussion/arguments are in reference to the claims in their amended form.

CLAIM REJECTIONS UNDER 35 USC §103

In the Final Office Action, Claims 1-28 are rejected under 35 USC §103(a) as being unpatentable over *Lahti, et al.* (International Pub No. WO 98/42173) in view of *Kleindienst, et al.* (US Pub 2004/0019487 A1). The combination of *Lahti* and *Kleindienst* does not render Applicants' claimed invention unpatentable because that combination does not suggest, to one skilled in the art at the time of Applicants' invention, several of the features recited by Applicants' claims.

General requirements for a claim rejection under 35 U.S.C. §103

According to 35 U.S.C. §103(a):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In order to make the obviousness determination, the U.S. Supreme Court held in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) (hereinafter *John Deere*) that four factors must be considered:

- (1) the scope and content of the pertinent prior art;
- (2) differences between the pertinent prior art and the invention at issue;
- (3) the ordinary level of skill in the pertinent art; and
- (4) objective evidence in the application indicating obviousness or nonobviousness.

As further established by case law, in order to support a finding of “obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art.” *Ex parte Newcomb*, Bd. of Pat. App. and Int. (March 31, 2008), citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (emphasis added); see also, *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“[O]bviousness requires a suggestion of all the elements in a claim.”) (emphasis added). Moreover, the Court of Appeals for Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (2006), quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Additionally, in rejecting claims under 35 U.S.C. §103, it is incumbent upon Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. i, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed- Cir. 1985,); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Further, the Manual of Patent Examination Procedure states that “the examiner should be fully aware of what the claims do not call for, as well as what they do require.” *MPEP §904.01*. (first emphasis in original, second emphasis added). In fact, it is well established that “[a]ll words in a claim must be considered in judging the patentability of [a] claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), quoted in *MPEP § 2143.03*. Finally, it is established that “[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ADT Corp. v. Lydall, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

The Rejection of Claims 1-28 under 35 U.S.C. § 103(a) is improper

The above combination of references fails to render Applicants' claimed invention unpatentable because: (a) neither of the references individually or in combination teach or suggest several of the features recited by Applicants' claims and (b) one skilled in the relevant art would not have found Applicants' claimed invention obvious over the combination. By the present amendments, the claims have been amended to more clearly and completely recite the novelty of Applicants' invention therein. For purposes of these arguments, Applicants will focus on example independent Claim 1. Among the novel features of Applicants' example Claim 1 that are not suggested by the above combination of references are at least the following non-exclusive features:

(1) autonomously validating, by the server, the data retrieved by the server DCI by comparing the data entered at the GUI to the SMS UET which has been retrieved by the server, to ensure that there are no data parameter errors and to ensure that the new SMS business message is properly formatted for the selected type of SMS business message format

(2) transmitting, by the server, the SMS MI to a wireless gateway for delivery of the SMS MI to a mobile recipient

As stated above, to establish a prima facie case of obviousness, "the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art." For those claim elements discussed above, the Examiner's combination of *Lahti* and *Kleindienst* fail to meet this standard for a 103 rejection.

On page 5 of the present Office Action the Examiner states that "Lahti does not explicitly disclose" the "autonomously validating" element of Applicants' example Claim 1. The Examiner uses *Kleindienst* to reject the "autonomously validating" element as claimed. *Kleindienst* discloses "[s]ystems and methods for multi-modal messaging that enable a user to compose, send and retrieve messages, such as SMS, MMS, IM or ordinary e-mail messages, for example, using one or more I/O (input/output) modalities (e.g., speech I/O and/or GUI I/O)" and that "[t]he user can dictate his/her messages using speech and/or GUI input..." (Abstract). However, upon reading the cited sections of *Kleindienst*, and *Kleindienst* as a whole, it would be obvious to one skilled in the art that *Kleindienst* is completely devoid of any teaching or suggestion of Applicants' "autonomously validating" element, as claimed. It is clear that *Kleindienst* is solely concerned with creating, sending, and retrieving of messages at a user's device, for example, as

disclosed in paragraph [0085] of *Kleindienst* (also cited by the Examiner). Paragraph [0085] of *Kleindienst* recites (emphasis added):

[0085] Referring again to FIG. 3, after a message is composed, the message is preferably displayed for user verification (step 44). The user has the option to edit the message (step 45). Once the message is finalized, the user can send the message to a desired addressee in a desired form. For instance, the user can select a desired addressee or addressees (step 46) by uttering the name(s) of the addressee(s). Further, the user can select the type of message to send (e.g., SMS or an e-mail message) (step 47) by either manual selection or by uttering "mobile" or "mail", for example.

As recited above, the user verification occurs on the user device before the user transmits the message to a desired addressee. Thus, there is no teaching or suggestion of "autonomously validating, by the server", or similar feature, as expressly claimed within Applicants' example Claim 1.

In contrast with *Kleindienst*, Applicants' Claim 1 recites "autonomously validating, by the server, the data retrieved by the server DCI by comparing the data entered at the GUI to the SMS UET which has been retrieved by the server, to ensure that there are no data parameter errors and to ensure that the new SMS business message is properly formatted for the selected type of SMS business message format". As recited within the claims, the "data collection interface (DCI)" of the server is "in communication with the computer". Thus, the "autonomously validating, by the server, the data retrieved", as claimed in Applicants' example Claim 1, is in direct contrast to the message "displayed for user verification", as disclosed by *Kleindienst*, and is not equivalent nor similar. Additionally, *Kleindienst* cannot teach the "autonomously validating" element because at least: (1) *Kleindienst* does not disclose or suggest a server performing any verification, nor any action whatsoever, (2) the user verification of *Kleindienst* is performed by a user at a user's device instead of being autonomously validated by a server, and (3) even under the pretense that a "user verification" is equivalent to "autonomously validating", the method disclosed by *Kleindienst* cannot be autonomous, because it is performed by a user. Since the combination of references does not teach or suggest the "autonomously validating" element of Applicants' Claim 1, Applicants' respectfully submit that example Claim 1 is allowable over the references.

On page 4 of the present Office Action, the Examiner cites page 2, lines 6-7 and page 7, lines 26-33 of *Lahti* as teaching the "transmitting" element of Applicants' Claim 1. However,

upon reviewing the cited sections of *Lahti*, and *Lahti* as a whole, it is clear that the Examiner is misinterpreting and/or mischaracterizing the *Lahti* reference. Neither *Lahti*, nor *Kleindienst*, teach or suggest "transmitting, by the server, the SMS MI to a wireless gateway for delivery of the SMS MI to a mobile recipient", or similar feature, as recited in Applicants' Claim 1. Rather, *Lahti*, generally provides a short message generated at a user terminal and sent to a service center. The short message is then routed to a bank's user interface server where pieces of the short message are transferred down to a bank self service unit and an banking transaction is executed. A message is then sent back to the user terminal indicating the achieved result of the banking transaction.

Applicants' claim 1, generally describes a server retrieving and validating a prepared business message from a business message template. The server then generates a SMS message instance (SMS MI) per the selected business message template and transmits the SMS MI to a mobile recipient. Upon receiving a reply from the mobile recipient, the server parses and decodes data from the received reply message and routes the decoded data to a specific application for processing. In short, the Applicants' invention recites a message generated at a server, sent to a user terminal, and receiving a reply back at the server. *Lahti*, in contrast, discloses a message created by a user at a user terminal, sent to a service center, and then the service center sending a results reply message back to the user. The method recited in Applicants' Claim 1 and the method disclosed by *Lahti* are therefore not representative or suggestive of, nor providing similar functionality to, each other.

Furthermore, Applicants' submit the payment templates disclosed by *Lahti* are not equivalent to the SMS universal encoding template (SMS UET) or business formats recited in Applicants' Claim 1. The SMS UET and business formatting, as recited in Applicants Claim 1 is applied to a message generated at the server and transmitted to a mobile recipient. The payment templates disclosed by *Lahti* are instead only applied in response to receiving a short message at the bank's user interface server from the user terminal. Since the combination of references does not teach or suggest these features, Applicants' respectfully submit that example Claim 1 is allowable over the references.

With the above discussion/arguments and the reasons provided therein, Applicants have explained the noted deficiencies in the various references and further explained why the references themselves and the combination of references do not suggest key features of

Applicants' claimed invention. One skilled in the art at the time of Applicants' invention would not find Applicants' invention to be suggested in light of the combination of references. The independent claims, and by virtue of their dependency, all other pending claims are therefore allowable over the combination.

CONCLUSION

Applicants have diligently responded to the Office Action by amending the claims to clarify and/or more completely recite the novel features recited within specific claims. Applicants have also explained which features of Applicants' claims are not obvious in light of the references provided or combination thereof. Since the amendments and arguments overcome the various claim rejections, Applicants respectfully request Examiner pass the claims to allowance and issue a Notice of Allowance for all claims now pending.

Applicants invite the Examiner to contact the undersigned attorney of record at 512.343.6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

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